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EXAMINER

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ART UNIT	PAPER NUMBER
3627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No. 09/528,693	Applicant(s) Wright et al
	Examiner Andrew J. Fischer	Art Unit 3627
<i>- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -</i>		
Period for Reply		
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Nov 8, 2002</u>		
2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are pending in the application.		
4a) Of the above, claim(s) <u>7-20</u> is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1-6</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>Mar 20, 2002</u> is/are a) <input type="checkbox"/> accepted or b) <input checked="" type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
*See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
6) <input type="checkbox"/> Other: _____		

Art Unit: 3627

DETAILED ACTION

Restriction

1. Applicants' election with traverse of Group I (claims 1-6) in Paper No. 8 is acknowledged. The traversal is on the grounds that each independent claim is not "a distinct invention." Specifically, Applicants argue "Claim 7 is not a subcombination of claim 1, nor is 1 a subcombination of claim 7." This is not found persuasive. The "web page apparatus" of claim 7 is clearly capable of being used in the product information apparatus. In fact, claim 1 actually claims "a web page" in line 9. Furthermore, claim 7 claims two "windows" within the body of the claim. Clearly "windows" are part of webpages. All elements within the body of claim 7 can be performed on a web page.

For this reason alone, the requirement is still deemed proper and is therefore made final.

2. Applicants also argue "that a search for claim 1 will also apply to claim 7." While this may or may not be true, Applicants have not asserted that "separate" or additional searches are not required. While Applicants traverse the Examiner's position, Applicants' have not stated "separate searches" are not required.

First, for simplicity of argument, assume all claim limitations in claim 1 will be summarized at "A". Next, assume claim 7 contains some overlapping elements which were also in claim 1 ("A") and that claim 7 has some additional elements "B." It is extremely important to note that Applicants have failed to argue that claims 1 and 7 are patentably distinct. Therefore, logic dictates that elements "B" in claim 7 *must* (by definition) contain patentably distinct features.

Art Unit: 3627

Because of the mandatory electronic searches required for application allowance in class 705,¹ the Examiner would be *required* to search for patentably distinct features of element “B”—even if claim 1 was searched and considered allowed.

Of course the Examiner’s argument fails if the groups of inventions are not patentably distinct. If Applicants expressly state on the record in response to this Office Action and *after each amendment* that the groups of inventions are *not* patentably distinct, the restriction will be withdrawn. However, until Applicants make this statement on the record, the requirement is still deemed proper and is therefore made final.

3. Regarding Applicants’ arguments directed towards paragraph 4 of the previous Office Action,² Applicants have merely restated the Examiner’s position and pointed out various factual details. The Examiner agrees that claim 11 requires the indicator to be directed to a “web page” as Applicants argue. However the Examiner’s restriction is based on a materially different “apparatus.”

4. Regarding Applicants’ arguments directed towards paragraph 6 of the previous Office Action, Applicants argue “inclusion or exclusion of a help window in claim 7 does not materially alter the apparatus that may practice the method of claim 7.” While this may or may not be true, the Examiner has carefully reviewed MPEP §800 and can find no legal standard for “materially

¹ See *Notification of Required and Optional Search Criteria for Computer Implemented Business Method Patent Applications in Class 705, and Request for Comments*, Federal Register, Vol. 66, No. 108, 30167, June 5, 2001.

² Previous Office Action mailed August 5, 2002 (Paper No. 6).

Art Unit: 3627

alter.” Applicants have failed to provide a definition for “materially alter,” an authority for their definition, and the legal standard applicable so that the Examiner may apply “materially alter” to the claims. It is quite possible that Applicants intended to state that the inclusion or exclusion of the help window does not make the claim patentably distinct. However, because Applicants chose “materially alter” over “patentably distinct,” the Examiner will presume (for Applicants’ benefit) that they intended *not* to equate the two standards.

The requirement is still deemed proper and is therefore made final.

Election of Species

5. After further search of the prior art and even though Applicants did not address the Election of Species in their last response, it is the Examiner’s position that Species 1 and Species 2 are not patentably distinct. Therefore, the Election of Species in the previous Office Action (Paper No. 6, Paragraphs 8 and 9) is hereby withdrawn.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a) because they are replete with errors. In particular the drawings fail to show various features as described in the specification: e.g. the indicator (102), the product information (104), and the product (106) as found on the first page of the “Detailed Description of the Preferred Embodiments.” Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP §

Art Unit: 3627

608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

- a. The “means for automatically interfacing to the internet” as recited in claim 6.

A proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objections to the drawings will not be held in abeyance.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the “means for automatically interfacing to the internet to access said web page based on said indicator.”

9. Applicants have neither numbered the paragraphs nor the pages in the specification. This makes identification of the specification difficult. The Examiner respectfully recommends numbering either the paragraphs or the pages in the specification.

10. On line 26 of a particular page, a typographical error is present: the “includeany.”

Art Unit: 3627

Claim Rejections - 35 USC § 112 2nd Paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The claims are replete with errors. Some examples follow.

- a. In claim 1, it is unclear whether the Applicants are claiming the subcombination of a product information apparatus or the combination of a product information apparatus and the product since Applicants recite in the body of claim 1 “an indicator . . . coupled to said product . . .”

If its Applicants intent to claim only the subcombination (product information apparatus), the body of the claim must be amended to remove any positive recitation of the combination. By way of example only, the Examiner suggests “an indicator associated with said product and the indicator being adapted to be coupled to said product . . .”

Alternatively, if Applicants intend to claim the combination, the preamble of the claims must be amended to be consistent with the language in the body of the claim. By way of example only, the Examiner suggests, “A product information apparatus in combination with a product . . .” As noted below and for prior art purposes, it is the Examiner position that only the apparatus (subcombination) is claimed.

Art Unit: 3627

b. In claim 5, the phrase “said memory is provided with said product” is indefinite and unclear. Claim 1 states that the “indicator . . . coupled to said product . . .” The Examiner interprets “provided with” to mean containing. In addition to the combination/subcombination issues above, it is unclear if the product itself is within the memory or product information is the memory.

c. In claim 6, it is unclear whether the Applicants are claiming the subcombination of a product information apparatus or the combination of a product information apparatus and the Internet since Applicants recite “means for automatically interfacing to the internet . . .”

d. Also in claim 6, it is unclear what structural elements make up the “automatically interfacing to the internet to access said web page based on said indicator” “Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.* 248 F.3d 1303, 1311, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001)(citations and quotations omitted). In other words, “[f]or claim clauses containing functional limitations in ‘means for’ terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification *must be* presented with sufficient particularity to satisfy the requirements of §112 ¶ 2. [Emphasis added.]” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted).³ In this case, Applicants have

³ “Failure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d

Art Unit: 3627

failed to clearly link or associate the means for phrase to some corresponding structure found in specification. Appropriate correction is required.

13. Regarding the combination/subcombination rejections, the Examiner simply asks: Is it the combination or subcombination Applicants intend to claim? Because this issue is frequently misunderstood, the Examiner will briefly attempt to show why this issue is of particular importance.

a. "Claims may not be construed one way in order to obtain their allowance and in a contrary way against infringers." *Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1021, 4 USPQ2d 1283, 1286 (Fed. Cir. 1987). The Examiner recognizes that for literal infringement purposes in an apparatus claim, a *subcombination* claim is much more valuable than a combination claim since literal infringement of a subcombination claim can occur at an earlier state of production when compared with a *combination* claim directed to the same subject matter. This is obvious since fewer structural elements are needed for literal infringement in a subcombination claim than would be needed for literal infringement in a corresponding combination claim. (E.g. It would be easier—structurally—to establish literal infringement of a claim directed towards a tire than a claim directed towards a vehicle having the tire.) However,

1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)). As a quid pro quo for the convenience of employing §112, paragraph 6, Applicant has a clear duty to clearly link or associate structure to the claimed function. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360, 54 USPQ2d 1308, 1313 (Fed. Cir. 2000) citing *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997).

Art Unit: 3627

with this lower structural threshold for literal infringement comes a lower structural threshold for anticipation.⁴ And since the Examiner's concern is patentability and not infringement,⁵ the Examiner's concern is *not* with which *type* of claim Applicants choose (i.e. combination or subcombination), but simply that a choice is made. And like any claims, once Applicants' intent (or choice) is known, the claims must comport to their intent.⁶

b. If Applicants intend to claim the subcombination (product information apparatus), logic dictates that only the product information apparatus (and structural elements associated with the product information apparatus) may be positively claimed. In this case, any structural elements outside the product information apparatus would be irrelevant since it is physically impossible (by definition) for them to be a part of the claimed product information apparatus.

It is the Examiner's factual determination that because claim 1 states "A product information apparatus . . . , said apparatus comprising:" a presumption is established that Applicants intend to claim only the product information apparatus (i.e. the subcombination).

⁴ There is a long recognized principle: "that which infringes if later, anticipates if earlier . . ." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573, 229 USPQ 561, 574 (Fed. Cir. 1986) citing *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889).

⁵ "The business of the PTO is patentability, not infringement." *In re Hogan* 559 F.2d 595, 607, 194 USPQ 527, 538 (CCPA 1977).

⁶ "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. §112, 2nd Paragraph (1994).

Art Unit: 3627

c. Alternatively, if Applicants intend to claim the combination (e.g. the product information apparatus in combination with the product or in combination with the Internet), Applicants must rebut this presumption. Again, Applicants may rebut this presumption by claiming "A system . . . comprising" *and* expressly indicating in their remarks that they intend to claim the combination. While the scope of this type of claim is less valuable for literal infringement purposes, the quid pro quo for employing this less valuable claim scope is that it usually is more difficult for the Examiner to establish anticipation or obviousness.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-6, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Cragun et. al. (U.S. 5,804,803)(“Cragun ‘803”). Cragun ‘803 discloses an indicator (code 117, translation program 110, and URL output; the bar code is a machine readable form of the URL) associated with a product; a web page (document 174) indicated by the indicator (via the URL); the indicator directs the web page to product information (inherent) where the information is provided to the user (via display screen 114); wherein the indicator is specific to each product (tangible object 115) such that a plurality of indicators are needed to find

Art Unit: 3627

out information about a plurality of products; the indicator (at least the bar code part) is disposed on the label which is on the object (tangible object 115 in Figure 1A); memory (106); and means for automatically interfacing with the Internet to access the web page (120 and 121).

16. Functional recitations using the word “for” (e.g. “for providing said product information” as recited in claim 1) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

17. Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner’s position that Applicants’ apparatus claims are clearly “product” or more specifically, “machine” claims.⁷

Additional evidence to support the presumption that claims 1-6 are product or machine claims is that claim 5 positively recites memory. “When a computer program is recited in

⁷ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

Art Unit: 3627

conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.” MPEP §2106 IV B. 1 (a) (last paragraph).

18. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)(“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).⁸

In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁹

⁸ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

⁹ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

Art Unit: 3627

However, if Applicants wish to use lexicography and desire a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicants in their next response to expressly indicate¹⁰ the claim limitation at issue¹¹ and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one

¹⁰ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

¹¹ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

Art Unit: 3627

reasonably skilled in the art on notice that the patentee intended to so redefine the claim term").¹²

The Examiner cautions that no new matter is allowed.

Failure by Applicants in their next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicants to forgo lexicography and to continue having the claims interpreted with their ordinary and accustom meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner's position that above requirements are reasonable.¹³ Applicants are also cautioned that even though claim interpretation begins with this presumption, the prosecution history may further limit claim scope if Applicants disclaim or disavow a particular interpretation of the claims during prosecution. *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002).

¹² See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), ("[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]"); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) ("Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention."). See also MPEP §2111.02, subsection titled "Applicant May Be Own Lexicographer" and MPEP §2173.05(a) titled "New Terminology."

¹³ The requirements are reasonable on at least two separate and independent grounds: first, the Examiner's requirements are simply an express request for clarification of how Applicants intend their claims to be interpreted. Second, the requirements are reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, June 3, 2002 available at www.uspto.gov/web/offices/com/strat2001/index.htm.

Art Unit: 3627

19. It is the Examiner's position that as understood by the Examiner, all claimed features in claims 1-6 are either disclosed or inherent in Cragun '803 as discussed above. Furthermore, any inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

35 U.S.C. 112 6th Paragraph

Means Phrase #1

Invocation

20. It is the Examiner's position that in claim 6, the phrase "means for automatically interfacing to the internet to access said web page based on said indicator" ("Means Phrase #1") is an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph. If Applicants disagree, the Examiner respectfully requests Applicants to either amend the claim to remove all instances of "means for" from the claim, or to explicitly state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6th paragraph should not be invoked.

Invocation Step 1:

- a. First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶* ("Guidelines")¹⁴, and *Al-Site*

¹⁴ Federal Register Vol 65, No 120, June 21, 2000.

Art Unit: 3627

Corp. v. VSI International Inc., 174 F.3d. 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),¹⁵ Applicant's use of "means for" in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6th paragraph. If the word "means" appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which §112 6th paragraph applies. *Id.* Since "means for" is recited in Means Phrase #1, this step is clearly met.

Invocation - Step 2:

b. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner's position that Applicants recite a corresponding function to the means—"automatically interfacing to the internet to access said web page based on said indicator."

The Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Here, the function as found in the Means Phrase #1 will have its ordinary meaning.

¹⁵ See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

Art Unit: 3627

Invocation - Step 3:

c. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, “the focus remains on whether the claim ... recites sufficiently definite structure.” *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the “automatically interfacing to the internet” can not be entirely performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner’s position that Means Phrase #1 invokes 35 U.S.C. 112 6th paragraph.

Corresponding Structure, Material, or Acts

21. In accordance with MPEP §2181, the Guidelines (section “II”) and *Medtronic*, 248 F.3d at 1311, 58 USPQ2d at 1614, “The next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the specification is

Art Unit: 3627

'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim." *Id.*

a. In our case and as noted above, the corresponding structure is not clearly linked in the written description with the required specificity. Therefore, a 35 U.S.C. 112 2nd paragraph rejection results. For example, the corresponding structure could be a modem, a DSL network, or some other network connection.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Rothschild (U.S. 6,430,554 B1); McAllister (U.S. 6,415,978 B1); Philyaw et. al. (U.S. 6,377,986 B1); Knowles et. al. (U.S. 6,321,992 B1); Hudetz et. al. (U.S. 6,199,048 B1); Philyaw et. al. (U.S. 6,098,106); Wiklof et. al. (U.S. 6,056,199); Shachar (U.S. 6,012,102); Hudetz et. al. (U.S. 5,978,773); Cragun et. al. (U.S. 5,971,277); Knowles et. al. (U.S. 5,869,819); Carrender et. al. (U.S. 5,850,187); and Ruppert et. al. (U.S. 5,640,002).

23. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

24. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicants with notice—for due process purposes—of his position regarding his factual

Art Unit: 3627

determinations and legal conclusions. If Applicants disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁶ the Examiner respectfully requests Applicants *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

 1/3/02
ANDREW J. FISCHER
PATENT EXAMINER

AJF
January 3, 2003

¹⁶ E.g., if the Examiner rejected a claim under §103, although not directly stated, it is the Examiner's implied position that the references are analogous art.